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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,852	12/21/2000	Charles A. Eldering	T721-19	8089

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TECHNOLOGY, PATENTS AND LICENSING, INC./PRIME
2003 SOUTH EASTON RD
SUITE 208
DOYLESTOWN, PA 18901

EXAMINER

SHELEHEDA, JAMES R

ART UNIT PAPER NUMBER

2623

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/742,852

Applicant(s)

ELDERING, CHARLES A.

Examiner

James Sheleheda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-6,55,56,59,60,75,78,79,90 and 91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-6,55,56,59,60,75,78,79,90 and 91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/6/06, 2/14/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/06/06 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4-6, 55, 56, 59, 60, 75, 78, 79, 90 and 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (Zigmond) (6,698,020) (of record) in view of Doherty (US2003/0200128A1) (of record).

As to claim 4, Zigmond discloses a subscriber system for inserting unscheduled advertisements into at least one channel of media signals (Fig. 7; column 6, lines 4-12, column 10, lines 64-67 and column 11, lines 1-3), the system comprising:

an ad insertion device (Fig. 5; ad insertion device, 80; wherein Fig. 5 is a detailed description of an insertion device used in Fig. 3) configured to determine an order in which an unscheduled advertisement (wherein the stored advertisements simply have rules associated with how to insert them, not specific time schedules; column 17, lines 21-28 and column 11, lines 31-49) is to be inserted into the at least one channel (column 11, lines 50-53 and lines 66-67, column 12, lines 1-9 and column 17, lines 21-25) and insert the unscheduled advertisement into the at least one channel according to the order (inserting the next selected advertisement when the trigger is detected; column 17, lines 21-31).

While Zigmond discloses a watchdog module (ad insertion device, 60) coupled to the ad insertion device (contained within the same device), the watchdog module configured to detect a change in current program content being display on the at least one channel (column 10, lines 40-47, column 11, lines 13-18 and column 12, lines 44-53) and output results to the ad insertion device (column 11, lines 13-18 and column 10, lines 40-47), such that the ad insertion device modifies the selection process (column 10, lines 40-47 and column 11, lines 13-17) and wherein a next unscheduled advertisement is selected (column 17, lines 21-25), he fails to specifically disclose determining an order in which advertisements are to be inserted and modifying the order based on a detected change.

In an analogous art, Doherty discloses a system for displaying targeted advertising (Fig. 1; paragraph 25, lines 1-6) wherein a scheduler (Fig. 1, 140) will create an order for ads to be inserted (schedule; paragraph 29), based upon current

advertisement priorities (paragraph 40), to determine the order in which advertisements are displayed (paragraph 38) and modifying the order in response to user action (paragraph 30) to ensure that the suitable advertisements are selected for the new current conditions (paragraphs 38 and 40) for the typical benefit of ensuring that advertisements are properly prepared when needed for output (Fig. 10; paragraphs 28, 38 and 55-57) when saving storage space by taking advantage of more comprehensive compression techniques (paragraph 28).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond's system to include determining an order in which advertisements are to be inserted and modifying the order based on a detected change, as taught by Doherty, for the typical advantage of ensuring that advertisements are properly prepared for display when needed thereby promoting efficient advertisement delivery.

As to claim 5, Zigmond and Doherty disclose a remote control device (see Zigmond at Fig. 8; input device, 150) in communication with the watchdog module (see Zigmond at column 9, lines 21-30 and lines 52-55), wherein the watchdog module detects change in the program content based on outputs from the remote control device (wherein the current program type, selected by the user, is monitored for ad selection; see Zigmond at column 10, lines 40-47, column 11, lines 13-18 and column 12, lines 44-53).

As to claim 6, Zigmond and Doherty disclose wherein said watchdog module detects change in the program content based on program information (monitoring the current program being viewed; see Zigmond at column 9, lines 21-30 and lines 52-55 column 12, lines 44-67 and column 13, lines 1-6) and outputs received from the remote control device (wherein the current program is inherently based upon the current channel selection; see Zigmond at column 9, lines 21-30 and column 12, lines 44-66 and Fig. 8).

As to claim 55, Zigmond and Doherty disclose wherein said ad insertion device determines if a particular change in the currently displayed program content (wherein the current program the user has selected is monitored for ad selection; see Zigmond at column 10, lines 40-47, column 11, lines 13-18, column 12, lines 44-column 13, line 14) is sufficient to modify the order (see Doherty at paragraph 30).

As to claim 56, Zigmond and Doherty disclose a tuner (wherein a broadcast television receiver inherently contains a tuner; see Zigmond at column 7, lines 13-25) configured to tune to a channel selected by the subscriber (column 9, lines 21-28 and column 13, lines 12-28), wherein said watchdog module detects change in program content (see Zigmond at column 9, lines 21-28 and column 13, lines 12-28) by monitoring what channel the tuner is tuned to (wherein channel changes, requiring tuning to a new channel, are monitored; see Zigmond at column 9, lines 21-28 and column 13, lines 12-28).

As to claim 59, Zigmond and Doherty disclose a profiler (viewer and system information, 82) configured to process subscriber interactions and generate a viewing session profile (see Zigmond at column 9, lines 65-67, column 10, lines 1-3 and lines 36-47 and column 11, lines 13-18), wherein the viewing session profile defines characteristics related to a subscriber for a viewing session (preferred channels and programs; see Zigmond at column 10, lines 40-47 and column 11, lines 15-18).

As to claim 60, Zigmond and Doherty disclose wherein said watchdog module detects changes to viewing session profiles (see Zigmond at column 10, lines 40-47) and wherein the ad insertion device also modifies the order (modifying the order based upon user action; see Doherty at paragraph 30) based on changes to the viewing session profiles (see Zigmond at column 10, lines 40-47 and column 11, lines 13-17).

As to claim 90, Zigmond discloses a method of presenting targeted advertisements to a subscriber viewing program content on a display device (Fig. 7; column 6, lines 4-12, column 10, lines 64-67 and column 11, lines 1-3), the system comprising:

detecting an advertisement space associated with the program content (column 15, lines 35-44);

presenting the targeted advertisements to the subscriber in the detected advertisement space (column 15, lines 52-65); and

detecting a change in program content currently being displayed to the subscriber (wherein the current program the user has selected is monitored for ad selection; see Zigmond at column 10, lines 40-47, column 11, lines 13-18, column 12, lines 44-column 13, line 14).

While Zigmond discloses unscheduled targeted advertisements to be presented to the subscriber (wherein the stored advertisements simply have rules associated with how to insert them, not specific time schedules; column 17, lines 21-28 and column 11, lines 31-49) and detecting a change in current program content being displayed to the subscriber (wherein the current program the user has selected is monitored for ad selection; see Zigmond at column 10, lines 40-47, column 11, lines 13-18, column 12, lines 44-column 13, line 14) and selecting an advertisement based upon a change in program content currently being displayed to the subscriber (selecting the next ad based upon the new currently viewed program; column 10, lines 40-47 and column 11, lines 13-17 and column 12, line 44-column 13, line 14), he fails to specifically disclose generating a queue indicating the order in which advertisements are to be presented and reordering the queue according to the detected change.

In an analogous art, Doherty discloses a system for displaying targeted advertising (Fig. 1; paragraph 25, lines 1-6) wherein a scheduler (Fig. 1, 140) will create an order for ads to be inserted (schedule; paragraph 29), based upon current advertisement priorities (paragraph 40), to determine the order in which advertisements are displayed (paragraph 38) and modifying the order in response to user action (paragraph 30) to ensure that the suitable advertisements are selected for the new

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current conditions (paragraphs 38 and 40) for the typical benefit of ensuring that advertisements are properly prepared when needed for output (Fig. 10; paragraphs 28, 38 and 55-57) when saving storage space by taking advantage of more comprehensive compression techniques (paragraph 28).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond's system to include determining an order in which advertisements are to be inserted and modifying the order based on a detected change, as taught by Doherty, for the typical advantage of ensuring that advertisements are properly prepared for display when needed thereby promoting efficient advertisement delivery.

As to claim 75, Zigmond and Doherty disclose wherein said detecting occurs by monitoring what channel the subscriber is viewing (see Zigmond at column 9, lines 21-28 and column 12, line 44-column 13, line 28).

As to claim 78, Zigmond and Doherty disclose profiling subscriber interactions (contained within viewer and system information, 82) in order to generate a viewing session profile (see Zigmond at column 9, lines 65-67, column 10, lines 1-3 and lines 36-47 and column 11, lines 13-18), wherein the viewing session profile defines characteristics related to a subscriber for a viewing session (preferred channels and programs; see Zigmond at column 10, lines 40-47 and column 11, lines 15-18).

As to claim 79, Zigmond and Doherty disclose detecting changes to viewing session profiles (see Zigmond at column 10, lines 40-47) and wherein reordering (modifying the order based upon user action; see Doherty at paragraph 30) is also based on changes to the viewing session profiles (see Zigmond at column 10, lines 40-47 and column 11, lines 13-17).

As to claim 91, Zigmond and Doherty disclose wherein the queue is reordered in real time (wherein the schedule is modified as interactions are detected; see Doherty at paragraphs 30 and 25).

Response to Arguments

4. Applicant's arguments filed 02/06/06 have been fully considered but they are not persuasive.

a. On pages 7-8, applicant argues that since Zigmond doesn't teach altering the order in which advertisements are displayed and Doherty doesn't disclose reordering his advertisements based upon program content, the combination of Zigmond and Doherty cannot teach the claimed invention.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

More specifically, Zigmond discloses an advertisement system wherein advertisement are selected based upon the current program being watched by the viewer (column 12, lines 44-53). Further, Zigmond specifically discloses wherein the system will monitor user actions such as channel changes and programming watched (column 11, lines 15-30). In response to the user action, such as changing the channel and programming being viewed, the system will select the next ad based upon the new current conditions (i.e. new program being viewed when an ad is to be inserted; Fig. 6, steps 108-116; column 12, lines 44-51 and column 17, lines 23-28).

Doherty discloses a system which creates a listing which indicates the order in which a plurality of upcoming advertisements are to be displayed (paragraphs 25, 29 and 38). In response to a user action (paragraphs 30 and 31) the system will then modify the order the ads are to be displayed (paragraphs 38 and 40) based upon the new current conditions (i.e. reordering the schedule based upon the changes in the priority in which ads should be displayed; paragraphs 38 and 40).

It is the combination of Zigmond and Doherty which then disclose a system wherein a plurality of ads are arranged in a particular order (as indicated in Doherty) based upon the currently displayed program (as indicated in Zigmond). The order of the ads is then altered based upon a change in the current conditions (as indicated by Doherty; paragraphs 38 and 40) which would include a change in the currently displayed program (as the ads are selected

based upon the currently viewed program; see Zigmond at column 12, lines 44-51; and the currently viewed program would change as a viewer changes channels; column 9, lines 21-28 and column 13, lines 12-28). Thus, applicant's arguments are not convincing.

b. In response to applicant's arguments on page 7, that Doherty's schedule is not reordered based upon program content, see the rejections and (a) above. As it is the combination of Zigmond with Doherty which clearly arrives at the claimed invention.

c. In response to applicant's arguments on page 8, in regards to the supposed "inconsistent" application of the references, see the rejections and (a) above. As repeatedly indicated, there is nothing inconsistent with the combination as Zigmond clearly teaches selecting ads based upon the current program and monitoring and detecting a change in conditions (i.e. a change in the current program). Doherty teaches creating an order for ads to be inserted and then altering that order based upon a change in the current conditions. Thus, as repeatedly indicated in the previous action and above, the combination of Zigmond and Doherty clearly teach the claimed invention.

d. In response to applicant's argument on pages 9-10, that there is no motivation to combine the references, and that the supplied motivation is not

contained within any of the references, it is noted that the cited motivation, as indicated in the rejections of claims 4 and 90 above, are clearly indicated by Doherty the system can compile and prepare advertisements in advance to eliminate any possible delay (see Doherty at paragraphs 28 and 38). As further indicated by Doherty, by providing the system more time to compile and prepare the ad, the system would be able to take advantage of image and video formats which are more compact than traditional MPEG and JPEG and would thus require much less storage size (paragraph 28).

e. In response to applicant's arguments on pages 10 and 11, in regards to the references teaching all of the claim limitations, see the rejections and (a) above.

f. In response to applicant's arguments on pages 1, in regards to the claim 90 (which is actually not a "new claim" as applicant's arguments suggest), see the rejections and (a) above.

Conclusion

5. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sheleheda whose telephone number is (571) 272-7357. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Sheleheda
Patent Examiner
Art Unit 2617

JS


CHRIS KELLEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600